

### **REMARKS**

Applicant has received and carefully reviewed the Office Action mailed May 8, 2007. Claims 1, 2, 13, 26, 27, 30, 31, 37, 40, 41, and 43 have been amended. Support for the amendments is found in the specification, claims, and drawings as originally filed. No new matter has been added. Reconsideration and allowance of the pending claims are respectfully requested.

### **Information Disclosure Statement**

The Examiner lined through one of the European patents (EP 1 251 767 A2, reference #94) listed on the 1449 filed July 16, 2004, but did not indicate why this reference has not been considered. A copy of the reference was provided with the IDS. If the Examiner did not receive a copy of the reference, an additional copy will be provided. If the reference was not considered for another reason, the Examiner is respectfully requested to indicate the reason.

### **Double Patenting**

Claims 1-10, 13-20, 23-34, 37-42, 44-46, 49-52, 54-56, 59-62, and 64-68 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1, 3, 14, 20, 33 of U.S. Patent No. 6,361,488. Applicant respectfully traverses the rejection. Independent claims 1, 13, 26, 37, and 62 recite, in part:

wherein the cross-sectional area of said passage at a first location is greater than the cross-sectional area of said passage at a second location, wherein the first location is distal to the second location

Independent claim 23 recites, in part, "said elongate body being enlargeable such that the passage at a distal location is larger than the passage at a proximal location." The cited claims of U.S. Patent No. 6,361,488 do not appear to recite at least these elements, and as such, the rejected claims appear to be patentably distinct for at least this reason. Reconsideration and withdrawal of the rejection are respectfully requested.

**Rejection under 35 U.S.C. § 102(b)**

Claims 1-10, 13-20, 23-34, 37-42, 44-46, 49-52, 54-56, 59-62, and 64-68 are rejected as being anticipated by Graber et al. (US 5,370,647). Independent claim 1, as amended, recites, in part, "said elongate body having a proximal portion and a distal portion, the distal portion having a rigidity sufficient to provide access to the surgical location". Graber et al. do not appear to teach such a structure. Graber et al. teach a "tissue and organ extractor 10 includes a hollow handle 20, an elongated, generally central shank 30, a ring 40 and an enveloping means 50." See column 4, lines 37-40. Graber et al. also teach the enveloping means 50 including "a flexible web 52 for enveloping the tissue or organ to be removed from a patient." Emphasis added; see column 5, lines 17-20. Graber et al. further teach "web 52 is preferably made from a sturdy water-proof, stain resistant fabric such as treated sail cloth or duck cloth." Emphasis added; see column 5, lines 40-42. Graber et al. do not appear to teach a structure having a rigidity sufficient to provide access to the surgical location. Applicant submits that the enveloping means 50 made of flexible web or fabric taught by Graber et al. would not inherently have a rigidity sufficient to provide access to a surgical location, as recited in the claim. Graber et al. thus do not appear to teach each and every element recited in independent claim 1 and the claims dependent thereon. Further, because Graber et al. teach the enveloping means 50 as specifically designed to surround and capture tissue or an organ for removal from the body, Graber et al. appear to teach away from modifying the enveloping means 50 to have a rigidity sufficient to provide access to a surgical location, as claimed.

Independent claim 13, as amended, recites, in part, "the elongate support arm having at least one adjustment mechanism configured to move the elongate body relative to the support arm." Graber et al. do not appear to teach such a structure. The Examiner appears to equate the cannula 4 of Graber et al. as the claimed support arm. While Graber et al. teach locking the extractor 10 into position in the cannula 4 with set screws 8 and 9, it appears that the user moves the extractor 10 manually within the cannula 4. See column 6, lines 14-40. Graber et al. do not appear to teach any structure that is configured to move the extractor 10 relative to the cannula 4. Graber et al. thus do not appear to teach each and every element recited in independent claim 13 and the claims dependent thereon.

Independent claim 23, as originally filed, recites, in part, "the support arm extending generally transverse to an axis defined along the passage of the elongate body between the proximal and distal ends." Emphasis added. The Examiner has not addressed this element in any rejection. Graber et al. do not appear to teach such a structure. The Examiner equates the cannula 4 of Graber et al. with the claimed support arm. As shown in Fig. 4 of Graber et al., the cannula 4 appears to extend along, rather than transverse to, an axis defined along the passage of the extractor 10. Graber et al. thus cannot be seen to anticipate the structure of independent claim 23, or the claims dependent thereon. Further, because Graber et al. teach the use of a cannula for supporting the extractor, which involves a supporting structure extending along the extractor, there does not appear to be any motivation or suggestion for one of ordinary skill in the art to modify the cannula of Graber et al. to achieve the structure as claimed.

Independent claim 26, as amended, recites, in part, "a second support arm configured to support a viewing device the second support arm coupled to the first support arm." Graber et al. do not appear to teach such a structure. Graber et al. appear to teach a system in which separate, non-coupled cannulas 4 and 5 are used, with the extractor 10 being inserted through one cannula 4, and a laparoscope being inserted through a auxiliary cannula 5. Thus, even if one were to equate the cannulas 4 and 5 of Graber et al. with the claimed first and second support arms, the claimed structure is distinguished from Graber et al. Graber et al. thus cannot be seen to teach each and every element of the structure recited in independent claim 26 or the claims dependent thereon. Further, because Graber et al. specifically teach the use of separate cannulas to visualize the interior of the abdominal cavity, Graber et al. appear to teach away from modifying their system to achieve the structure as claimed.

Independent claim 37, as amended, recites, in part, "a support arm configured to support the elongate body and to support an additional device relative to the passage of the elongate body." As discussed above, Graber et al. appear to teach a cannula 4 for supporting the extractor 10, and a separate, auxiliary cannula 5, for supporting an additional device such as a laparoscope. Graber et al. thus do not appear to teach a support arm configured to support both an elongate body and an additional device, as is recited in the claim. Graber et al. thus cannot be seen to teach each and every element of the structure recited in independent

claim 37 or the claims dependent thereon. Further, because Graber et al. specifically teach the use of separate cannulas to visualize the interior of the abdominal cavity, Graber et al. appear to teach away from modifying their system to achieve the structure as claimed.

Independent claim 62, as originally filed, recites, in part, "a viewing device operably coupled with the elongate body." Graber et al. do not appear to teach such a structure. As discussed above, Graber et al. appear to teach an extractor 10 and a separate laparoscope, where the extractor and laparoscope are disposed in separate cannulas during the procedure. Graber et al. thus do not appear to teach a viewing device operably coupled with the elongate body, as is recited in claim 62. Graber et al. thus cannot be seen to teach each and every element of the structure recited in independent claim 62 or the claims dependent thereon. Further, because Graber et al. specifically teach the use of separate cannulas to visualize the interior of the abdominal cavity, Graber et al. appear to teach away from modifying their system to achieve the structure as claimed. Reconsideration and withdrawal of the rejection are respectfully requested.

**Rejection under 35 U.S.C. § 103(a)**

Claims 11, 12, 21, 22, 35, 36, 43, 47, 48, 53, 57, 58, and 63 are rejected as being unpatentable over Graber et al. For at least the reasons set forth above, Graber et al. do not appear to teach each and every element of the independent claims from which the above claims depend. Further, there is no motivation or suggestion for one of ordinary skill in the art to modify the device of Graber et al. to achieve the claimed structure. Reconsideration and withdrawal of the rejection are respectfully requested.

Reconsideration and reexamination are respectfully requested. It is submitted that, in light of the above remarks, all pending claims are now in condition for allowance. If a telephone interview would be of assistance, please contact the undersigned attorney.

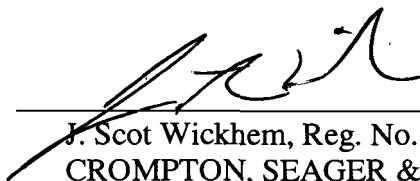
Respectfully Submitted,

THOMAS W. DAVISON

By his Attorney,

Date: \_\_\_\_\_

September 4, 2007



J. Scot Wickhem, Reg. No. 41,376  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349